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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,739	09/18/2003	Daniel J. Teff	328.7689USU	4691

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,739

Applicant(s)

TEFF ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 88 is/are pending in the application.
- 4a) Of the above claim(s) 38 to 88 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 to 37 is/are allowed.
- 6) ☒ Claim(s) 1 to 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 to 37, drawn to a siloxane composition, classified in class 528, subclass 31.
 - II. Claims 38 to 88, drawn to a process, classified in class 427, subclass 255.27.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process, such as a process of coating a composition from a solvent based liquid solution, or a method of making an curable silicone rubber.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Paul Greeley on 1/13/06 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 38 to 88 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 to 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayorga et al.

Mayorga et al. teach a method of stabilizing polymers. See the cyclosiloxane on top of column 3, which meets claimed component (a). For instant claims 3 to 8, note that the siloxane in claim 2 is not limited to the linear compound and as such these claims are met by Mayorga et al. For claims 9 to 11, note that the siloxanes in Mayorga et al. fully meet these claims. See for instance 1,3,5,7 tetramethylcyclosiloxane on line 43 which is a specific siloxane in claim 11.

Mayorga et al. stabilize the polymers therein by adding free radical scavengers such as BHT (column 4, lines 63 and 64) or phenols (column 4, line 24). BHT is a specific antioxidant claimed in claim 13. Particular attention is drawn to Table 3 which adds BHT in an amount meeting claims 14 and 15. In this manner the instant claims are fully met by the teachings in Mayorga et al.

8. Claims 16 to 36 are allowed.

The prior art fails to teach or suggest such a composition. Specifically there is no motivation to add the silane component to a composition such as that in Mayorga et al. in an amount as claimed. While silanes within the breadth of (c) have been known components in preparing semiconductors and have, in fact, been used in the alternative

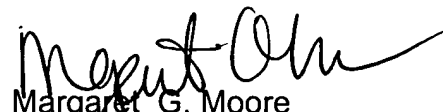
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with 1,3,5,7 tetramethylcyclsiloxane to (see for instance lines 25 to 45 in 5,470,800) there is nothing in the prior art that would suggest the addition of such silanes to the composition in Maryorga et al. in the particular and small amount as claimed. Mayorga et al. discuss TEOS in comparison to 1,3,5,7 tetramethylcyclsiloxane for making SiO₂ films (column 1) and this discussion would, in fact, seem to lead one away from including TEOS in this prior art composition. Note for instance that the different boiling points would suggest an incompatibility.

9. Chen et al. is cited as being of general interest. This reference has a filing date later than the effective filing date. The parent application 10/015,326 does not support the necessary teachings in Chen et al. to use this reference as prior art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
1/16/06